

### Remarks

Claims 1-6, 9-11 and 13-19 are currently pending in the present patent application. Claims 7-8 and 12 were previously cancelled.

### Claims 1-6, 9-11 and 13-18, Rejected Under 35 USC § 103(a)

Claims 1-6, 9-11 and 13-19 have been rejected under 35 USC § 103(a) as being unpatentable over Keyworth et al. (US 5,579,472, hereinafter “Keyworth”) in view of Cooper et al. (U.S. 6,466,654 B1, hereinafter Cooper), and further in view of Wagner (U.S. 2004/0155908 A1, hereinafter Wagner).

#### *Legal Standards.*

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base rejection of claims 1-6, 9-11 and 13-19 upon a purported teaching, suggestion or motivation to combine elements from Keyworth, Cooper, and Wagner. The only pending grounds for rejection, therefore, are based upon a “teaching, suggestion or motivation” analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP 2143)

The above principles pertaining to the Examiner’s duty are in harmony with the decision from the United States Supreme Court, *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007). The Supreme Court’s *KSR* decision characterized a “teaching, suggestion or motivation” analysis as “a helpful insight.” *KSR* slip op. at 14-15. When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or

motivation to select and combine features from the cited references. *E.g., In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

As will be discussed below, the cited references fail to disclose or suggest all of the elements recited in the claims. When the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation. Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

*The Cited References Fail to Disclose or Suggest Each and Every Claim Element.*

The Independent Claims.

The cited references fail to disclose or suggest all of the elements recited in the independent claims. Consequently, the Examiner has not met the Examiner's legal burden of proof. Even if there is a teaching, suggestion or motivation supported by the record (a point that the Applicant does not concede), such an impetus cannot cure this defect in the Examiner's case. Regardless of what impetus one skilled in the art might or might not have had, one skilled in the art could not combine the elements in the references to create the claimed combination of elements.

It is respectfully submitted that upon considering the disclosures of Keyworth, Cooper and Wagner whether individually or in combination, one skilled in the art would not consider providing "a first indicator of the presence of a number of unread electronic messages

received” and “enabling scanning of the unread electronic messages received without reading” and then “altering said first indicator to provide a second indicator at the location on the visual display that provides a visually distinguishable annunciation by altering said first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned” (emphasis added) as recited in claim 1 (and similarly in claims 4 and 11), as neither of the cited references individually, nor in combination disclose or suggest such elements.

Likewise, upon considering the disclosures of Keyworth, Cooper and Wagner, whether individually or in combination, one skilled in the art would not consider providing “a first indicator of the presence of a number of unread electronic messages received, the first indicator including a count to indicate the number of unread electronic messages received” and “enabling scanning of the unread electronic messages received without reading” and then “providing a second indicator at the location on the visual display, the second indicator including a count to indicate the number of unread electronic messages received and an indication that at least one of the unread electronic messages has been received since the unread electronic messages received were last scanned” (emphasis added) as recited in new claim 19.

Keyworth is directed to a system for displaying and processing communications via a variety of communications media using a personal computer (abstract). Messages received either wirelessly or over a telephone wireline are segregated and presented for review by the subscriber according to whether the originator is within a select group of routinely contacted individuals and also by type of media (abstract). Status indicators 89a are provided in a command box 81 to indicate whether received messages are either “old” (previously read) or “new” (just received) (see col. 6, lines 49-52 and col. 7, lines 6-9). Keyworth does not disclose or even contemplate altering an indicator to provide a second indicator that provides a visually distinguishable annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned, as admitted by the Examiner on page 3 of the most recent Office Action.

The Examiner then relies upon the additional disclosure of Cooper to compensate for the lack of disclosure of Keyworth. The Examiner asserts “Cooper discloses distinguishing between new unread messages received since the user last checked, i.e. scanned, messages,

old unread messages and old read messages (column 3, lines 20-22, column 6, lines 62, column 50, lines 41-44).” A careful reading of the portions of Cooper identified by the Examiner along with related text reveal no such disclosure or contemplation of such disclosure. For instance, column 3, lines 20-22 of Cooper merely provides that the “taggable field value for the status field is first, last, new, old, read, unread, deleted or urgent” and column 50, lines 41-44 provides:

“New” messages are those that have been received since the user last called the VA (and, perhaps, since the user last checked messages on a personal computer). “Old” messages include all other messages, even if they have not been read. (emphasis added)

Accordingly, Cooper, similar to Keyworth, is only concerned with indicating if messages are “old” or “new” and does not disclose providing any indication that new unread electronic messages have been received since the unread electronic messages received were last scanned. The disclosure that the taggable field value for the status field is “first, last, new, old, read, unread, deleted or urgent” is simply that the status field is one of those values (e.g., first, last, new, old, read, unread, deleted or urgent), **not** a combination of those (e.g., new read, old read, old unread, new unread) as the Examiner has apparently interpreted. Accordingly, Cooper does not disclose providing an indicator of “old unread” or “old read” as asserted by the Examiner.

As such, Cooper, like Keyworth, does not disclose or suggest altering an indicator to provide a second indicator that provides a visually distinguishable annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned.

Furthermore, the additionally cited reference of Wagner, directed toward a context based mobile device display, like Keyworth and Cooper, does not disclose or suggest altering an indicator to provide a second indicator that provides a visually distinguishable annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned.

As the cited art fails to disclose or suggest all the elements recited in claims 1, 4, 11, and 19 such claims are patentably distinguishable from the combination of Keyworth, Cooper and Wagner when combined and thus should be allowed in light of the cited art.

Since independent claims 1, 4 and 11 are believed to be allowable over Keyworth, Cooper and Wagner for the reasons provided above, dependent claims 2-3, 5-6, 9-10 and 13-18 which depend therefrom are also believed to be allowable as a matter of law as well.

*The Examiner has Relied Upon Improper Rationale For Combining Keyworth, Cooper and Wagner.*

The Examiner has Relied Upon Improper Hindsight.

Regarding the Examiner's contention that the present claimed concept would have been obvious to one skilled in the art in light of the teaching of Keyworth, Cooper and Wagner, it is respectfully submitted that even if the cited art did in fact disclose all of the elements presented in the claims (a point which Applicant clearly demonstrated is not the case, [see above]), the rationale relied upon by the Examiner is improper.

In attempting to provide support for combining the teachings of Keyworth, Cooper and Wagner, the Examiner has clearly relied at best upon impermissible hindsight reasoning as no motivation to make the combination can be found in the art itself. As previously discussed, none of the references disclose or suggest providing an indication beyond that of "old" or "new" and do not contemplate providing a more detailed indication such as recited in the present claims. Instead, the benefits of such detailed indication is provided in the disclosure of the present application.

In attempting to support the suggested combination of references, the Examiner provides:

One could have been motivated to add an annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned to Keyworth because, as disclosed in Keyworth, a user must make note of when a message was last received to determine if it is a new unread message since the user last brought up the wireless mail display (column 8, lines 49-62), and including an annunciation of the messages that are new and unread since the user last brought up the wireless message display would provide an easy way for the user to distinguish these messages from other unread messages.

The cited portion of Keyworth (column 8, lines 49-62) refers to Fig. 11 which shows the use of the descriptors "new" for messages "just received" and "old" for messages "read or heard" (see col. Col. 7, lines 6-9). The cited portion does not appear to suggest the deficiency

indicated by the Examiner as the cited portion does not indicate that a user must make note of anything, aside from plainly reading if a message is listed as “new” or “old.” In contrast, the indication taught by Keyworth itself, as shown in Fig. 11, appears to propose a solution to distinguishing between old and new messages. Accordingly, the motivation proposed by the Examiner to combine Keyworth and Cooper does not appear to be any motivation at all.

Accordingly, it is respectfully submitted that even if the cited combination did disclose all of the elements recited in the claims (a point Applicant obviously does not concede [see above]), the art itself lacks any motivation to make the combination suggested by the Examiner.

Reconsideration and withdrawal of the rejection to claims 1-6, 9-11 and 13-19 under 35 USC § 103(a) is respectfully requested.

### **Conclusion**

In view of the remarks above, Applicant respectfully submits that the application is in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

No fee is currently believed to be due, however if any fees are determined to be due, the Commissioner is hereby authorized to charge any such fees or credit any overpayment to Eckert Seamans Cherin & Mellott, LLC Deposit Account No. 02-2556.

Respectfully submitted,

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